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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,382	11/15/2000	Clayton A. George	54680USA8B.008	4594

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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/14/2003

*14*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/713,382

Applicant(s)

GEORGE ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

### ***Response to Amendment***

3. Newly presented claims 21-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-8 of U.S. Patent No. 6316099 in view of EP 0392090, substantially for the reasons set forth in section 8 of Paper No. 9, together with the following additional observations.

The Examiner disagrees with Applicants' Response arguing that claims 21-28 depend from original claims 11-20 in USSN 09/409520 (Response, page 5, paragraphs 3-4). It is noted that the instant claims 11-20 do depend from the original claims. However, claims 21-28 and the newly amended claims 29-30 are new claims.

4. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al. (US 6284360) in view of Sekisui Chemical Co. (JP 10195393), substantially for the reasons set forth in section 3 of Paper No. 11, section 10 of Paper No. 9 and section 6 of Paper No. 5, together with the following additional observations.

With respect to Applicants' argument that there is no disclosure, teaching or suggestion in Johnson et al., Sekisui '393, or the combined teaching of Johnson with Sekisui that would motivate the person of ordinary skill in the art to substitute a multi-

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layered pressure sensitive adhesive laminate for the sealant layer in the articles of Johnson (Response, page 7, first paragraph), the Examiner reiterates that both Sekisui's and Johnson's inventions are directed to the same field of endeavor, that is a curable (e.g., thermoset) sealant for jointing members. As such, it would have been obvious to one of ordinary skill in the art to combine the teachings of Sekisui and Johnson (see section 3 of Paper No. 9).

With respect to Applicants' argument that the Johnson teaches away from Sekisui by providing the definition of the "sealant composition" and "sealant layer", which expressly excludes pressure sensitive adhesives (Response, page 7, second paragraph), the Examiner would like to point out that while Applicants may be his or her own lexicographer, it is noted that Johnson also appear to be limiting the definition of the "pressure sensitive adhesive" to un-cured adhesives (column 2, lines 7-21), whereas Sekisui is directed to a "curable sticking sheet for jointing members" (Derwent Abstract of JP 10195393), which is clearly consistent with the definition of "thermosetting sealant compositions" provided by Johnson (column 2, lines 2-6 and 22-31). As such, it would have been obvious to one of ordinary skill in the art of thermosetting sealant to substitute Johnson's adhesive layer, motivated by the desire to obtain an excellent initial adhesive strength imparted by the difference in curing rate, as taught by Sekisui.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

VSC  
January 10, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*